UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	Christopher J. Stone, et al.	GROUP ART UNIT:	2623
APPLN. NO.:	10/725,144	EXAMINER:	Taylor, Joshua D.
FILED:	December 1, 2003	Confirmation No.:	1770
TITLE:	**METHODS AND APPARATUS FOR PASSING AN ON-SCREEN DISPLAY OVER A SERIAL INTERFACE**		

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action mailed from the U.S. Patent and Trademark Office on September 5, 2008, Applicant requests review of the final rejection in the above-identified application. This request is being filed with a Notice of Appeal and required fee. An extension of time is requested and this response is accompanied by the fee required under 37 C.F.R. 1.136(a). The Commissioner is hereby authorized to charge any additional fees which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account No. 50-2117.

No amendments are being filed with this request. The review is requested for the reasons stated in the remarks below.

STATUS OF CLAIMS

Claims 1-26 are pending in this application.

The Office Action dated September 5, 2008, rejects claims 1-2 and 14-15 under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 6,490,002 to Shintani (hereinafter "Shintani"). The Office Action also rejects claims 3-13 and 16-26 under 35 U.S.C. § 103(a) as being unpatentable over Shintani in view of U.S. Patent No. 6,137,539 to Lownes et al. (hereinafter "Lownes").

REMARKS

Claim Rejections – 35 U.S.C. § 102

Claims 1-2 and 14-15 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Shintani. Applicants respectfully traverse the rejections.

Shintani discloses a high definition television (HDTV) that "has separate inputs for the analog signal and the high definition digital signal, which is decoded in the HDTV to a format suitable for display on the HDTV monitor" (Shintani, Abstract).

The present application discloses methods and apparatus by which a "source device passes the on-screen display (OSD) through an MPEG encoder to produce an isochronous MPEG data stream, which can be passed over an IEEE-1394 connection to the sink device." (Page 4, lines 12-14.) The source device is a device such as a "cable/satellite/off-air television receiver terminal" (page 2, line 3) or a "cable television receiver terminal" (page 4, lines 24-25), e.g., a set-top box. The sink device is, for example, "a high definition television (HDTV)" (p. 2, line 4).

In the present application, independent claim 1 recites "encoding the on-screen display at the source device as an isochronous MPEG data stream," and independent claim 14 recites a "source device . . . comprising . . . an MPEG encoder adapted for encoding said graphic data as an isochronous MPEG data stream carrying said on-screen display".

The Office Action incorrectly states that Shintani discloses this feature. The Office Action cites Shintani at col. 7, lines 21-43 and Fig. 5, element 370, for this feature, contending that "Necessarily, since the video stream is MPEG encoded, the OSD must

also be MPEG encoded at the STB to decode the MPEG signal by the MPEG decoder of the HDTV" (Office Action, page 3).

Applicants respectfully point out that, notwithstanding the inference made in the Office Action, Shintani fails to disclose that the OSD is MPEG encoded in the STB. The feature of "encoding the on-screen display at the source device as an isochronous MPEG data stream" is not taught or disclosed by Shintani. To the contrary, Shintani teaches disadvantages of encoding the on-screen display at the STB (see col. 2, lines 29-53).

Because Shintani fails to disclose "encoding the on-screen display at the source device as an isochronous MPEG data stream," as recited in independent claim 1, and fails to disclose a "source device . . . comprising . . . an MPEG encoder adapted for encoding said graphic data as an isochronous MPEG data stream carrying said on-screen display," as recited in independent claim 14, claims 1 and 14 are not anticipated by Shintani. Claims 2 and 15, which depend respectively from claims 1 and 14, are also not anticipated by Shintani at least by virtue of their dependency upon allowable base claims.

As Shintani fails to disclose each and every element of claims 1-2 and 14-15, Applicants respectfully submit that claims 1-2 and 14-15 are not anticipated by Shintani, and request that the rejection of claims 1-2 and 14-15 under 35 U.S.C. § 102(b) be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 3-13 and 16-26 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Shintani in view of Lownes. Applicants respectfully traverse the rejections.

For at least the reasons previously stated above, independent claims 1 and 14 are allowable. Likewise, dependent claims 3-13 and 16-26, which depend on claims 1 and 14 respectively and incorporate all of the limitations thereof, are similarly patentable. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3-13 and 16-26 under 35 U.S.C. § 103(a).

Lownes fails to disclose "encoding the on-screen display at the source device as an isochronous MPEG data stream," as recited in independent claim 1, and fails to disclose a "source device . . . comprising . . . an MPEG encoder adapted for encoding

said graphic data as an isochronous MPEG data stream carrying said on-screen display," as recited in independent claim 14. Since Lownes fails to supply features missing from Shintani, the combination of Shintani and Lownes cannot suggest the presently claimed invention and cannot render the claims obvious. Thus, no matter how Shintani and Lownes may be combined (even assuming, arguendo, that one of ordinary skill in the art would be led to combine them) the resulting combination is not the invention recited in dependent claims 3-13 and 16-26.

Furthermore, the combination of Shintani with Lownes, or with other prior art references, is an improper basis for rejecting Applicants' claims at least because Shintani **teaches away** from the presently claimed invention.

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)). Shintani specifically teaches disadvantages of encoding the on-screen display at the STB (see col. 2, lines 29-53). Thus, a person of ordinary skill, upon reading the Shintani reference, would be led in a direction divergent from the path that was taken by the Applicants. Therefore, Applicants respectfully submit that Shintani fails to provide a basis for a rejection under 35 U.S.C. § 103. Because Shintani is an **improper basis** for rejecting Applicant's claims, the combination of Shintani with Lownes, or with any other prior art references, is also an improper basis for rejecting Applicants' claims.

For at least the reasons previously stated, independent claims 1 and 14 are allowable. Likewise, dependent claims 3-13 and 16-26, which depend on claims 1 and 14 respectively and incorporate all of the limitations thereof, are similarly patentable. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3-13 and 16-26 under 35 U.S.C. § 103(a).

Claims not specifically mentioned above are allowable due to their dependence on an allowable base claim. In light of the arguments presented above, it is respectfully submitted that all pending claims are in condition for allowance. Reconsideration and withdrawal of the final rejection of the claimed invention is respectfully requested.

Respectfully submitted,
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